

The opinion in support of the decision being entered today was **not** written for publication and is **not** binding precedent of the Board.

Paper No. 26

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte FRANCOIS GIRARD

Appeal No. 2004-1202
Application No. 09/908,938

HEARD: AUGUST 19, 2004

Before COHEN, STAAB, and McQUADE, Administrative Patent Judges.
COHEN, Administrative Patent Judge.

DECISION ON APPEAL

This appeal is taken from the final rejection of claims 1 through 12, 14 through 24, 26 through 30, and 32 through 40. In the answer (pages 4 and 5), the examiner withdrew the rejection of claims 2, 18, and 34; however, these otherwise allowable claims now stand objected to by the examiner as being based upon their dependency from rejected base claims. Claims 13, 25 and 31, the only other claims in the application, stand allowed. It follows that rejected claims 1, 3 through 12, 14 through 17, 19

Appeal No. 2004-1202
Application No. 09/908,938

through 24, 26 through 30, 32, 33, and 35 through 40 are before us for review.

Appellant's invention pertains to a tightening device, adapted to equip an article of footwear including a sole, and to an article of footwear. A basic understanding of the invention can be derived from a reading of exemplary claims 1, 17, 29, and 30, respective copies of which appear in the APPENDIX to the main brief (Paper No. 17).

As evidence of anticipation, the examiner has applied the documents listed below:

Frykberg	5,483,757	Jan. 16, 1996
King et al	2,626,447	Aug. 4, 1989
(King) (France) ¹		

¹ Our understanding of this French document is derived from a reading of an English translation thereof provided by appellant (appended to the main brief).

Appeal No. 2004-1202
Application No. 09/908,938

The following two anticipation rejections are before us for review.

1. Claims 1, 3, 5 through 12, 14 through 17, 19, 21 through 24, 26 through 30, 32, 33, 35, and 37 through 40 stand rejected under 35 U.S.C. § 102(b) as being anticipated by King.

2. Claims 1, 4 through 6, 9 through 11, 14 through 17, 20, 21, 27 through 30, 36, 37, and 40 stand rejected under 35 U.S.C. § 102(b) as being anticipated by Frykberg.

The full text of the examiner's rejections and response to the argument presented by appellant appears in the answer (Paper No. 18), while the complete statement of appellant's argument can be found in the main and reply briefs (Paper Nos. 17 and 21).

OPINION

In reaching our conclusion on the anticipation issues² raised in this appeal, this panel of the board has carefully considered appellant's specification³ and claims, the applied teachings, and the respective viewpoints of appellant and the

² Anticipation under 35 U.S.C. § 102(b) is established only when a single prior art reference discloses, either expressly or under principles of inherency, each and every element of a claimed invention. See In re Schreiber, 128 F.3d 1473, 1477, 44 USPQ2d 1429, 1431 (Fed. Cir. 1997); In re Paulsen, 30 F.3d 1475, 1478-79, 31 USPQ2d 1671, 1673 (Fed. Cir. 1994); In re Spada, 911 F.2d 705, 708, 15 USPQ2d 1655, 1657 (Fed. Cir. 1990); and RCA Corp. v. Applied Digital Data Sys., Inc., 730 F.2d 1440, 1444, 221 USPQ 385, 388 (Fed. Cir. 1984). However, the law of anticipation does not require that the reference teach specifically what an appellant has disclosed and is claiming but only that the claims on appeal "read on" something disclosed in the reference, i.e., all limitations of the claim are found in the reference. See Kalman v. Kimberly-Clark Corp., 713 F.2d 760, 772, 218 USPQ 781, 789 (Fed. Cir. 1983), cert. denied, 465 U.S. 1026 (1984).

³ As acknowledged by appellant in the specification (page 2), prior to the present invention, a known mountain hiking boot (DE 42 29 036) evidenced the feature of overlapping quarters having "substantially identical flexibility." As to the latter configuration, however, it is not clear to us as to whether the upper quarter (overlapping) is more flexible than the lower quarter in the noted foreign language disclosure, considering the content of appellant's independent claims in the present application.

examiner. As a consequence of our review, we make the determinations which follow.

The first rejection

We cannot sustain the rejection of claims 1, 3, 5 through 12, 14 through 17, 19, 21 through 24, 26 through 30, 32, 33, 35, and 37 through 40 under 35 U.S.C. § 102(b) as being anticipated by King.

Each of appellant's independent claims 1, 17, 29, and 30 requires, inter alia, the feature of an upper (overlapping) flap being more flexible than a lower flap.

In support of the view that the independent claims are anticipated by, i.e., read on, the teaching of King, the examiner offers three alternative perspectives (answer, page 3) of the boot configuration of King (reflected in the color-coded drawing appended to the answer) that are indicated to respond to the upper flap recitation of independent claims 1, 17, 29, and 30.⁴

⁴ In our view, and contrary to the position taken by the
(continued...)

The difficulty we have with the examiner's rejection is that the selected King reference is silent as to any difference in flexibility between an upper and lower flap. Further, and of particular importance, we readily discern that one versed in the art would appreciate that it would be sheer speculation as to whether the upper flap (the earlier indicated composite of the inner and outer layers 18, 19, the strap 12, and the element 23) of King is more flexible than the lower flap (portrayed on the left side of the lower portion of Fig.4). Since the examiner has not proffered a sound reference that independent claims 1, 17, 29, and 30 read on, we are constrained to reverse this anticipation rejection.

The second rejection

⁴(...continued)
examiner, one skilled in this art would not understand a layer of material by itself in the King teaching, e.g., either layer 18 or and 19, to connote an upper flap, as claimed. Instead, as we see it, the upper flap of King would be understood to be the composite of inner and outer layers 18, 19, strap 12, and element 23 (Fig. 4).

We cannot sustain the rejection of claims 1, 4 through 6, 9 through 11, 14 through 17, 20, 21, 27 through 30, 36, 37, and 40 under 35 U.S.C. § 102(b) as being anticipated by Frykberg.

Akin to the circumstance with the first rejection, supra, the examiner considers independent claims 1, 17, 29, and 30 to be readable on the healing sandal disclosed by Frykberg (Figs. 1 and 2). However, as was the case above, the examiner has chosen as evidence of anticipation a patent which does not mention any difference in flexibility between an upper flap and a lower flap. In fact, as pointed out by appellant (reply brief, page 8), and contrary to the examiner's finding (answer, page 7), the Frykberg reference does not even indicate the material of the strap 14 (upper flap). Thus, it is without question but that it would be pure speculation as to whether the strap 14 of Frykberg is more flexible than the side panel 40 (lower flap). Since, as indicated, the examiner has not applied a sound reference that appellant's independent claims read on, we are constrained to reverse this anticipation rejection.

In summary, this panel of the board has not sustained the two rejections on appeal.

Appeal No. 2004-1202
Application No. 09/908,938

The decision of the examiner is reversed.

REVERSED

IRWIN CHARLES COHEN)	
Administrative Patent Judge)	
)	
)	
)	
)	BOARD OF PATENT
LAWRENCE J. STAAB)	APPEALS
Administrative Patent Judge)	AND
)	INTERFERENCES
)	
)	
)	
JOHN P. McQUADE)	
Administrative Patent Judge)	

ICC:pgc

Appeal No. 2004-1202
Application No. 09/908,938

GREENBLUM & BERNSTEIN, P.L.C.
1950 ROLAND CLARKE PLACE
RESTON, VA 20191